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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/539,287	03/30/2000	David V. Pedersen	P48D1-US	8250

7590

07/11/2003

David Larwood
FormFactor INC
5666 LaRibera Street
Livermore, CA 94550

EXAMINER

NORRIS, JEREMY C

ART UNIT

PAPER NUMBER

2827

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

TECHNOLOGY CENTER 2000

2003-5-26

2003-5-26

Office Action Summary	Application No.	Applicant(s)	
	09/539,287	PEDERSEN ET AL.	
	Examiner	Art Unit	
	Jeremy C. Norris	2827	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41,43-46,49,54,55,57-60 and 65-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41,43-46,49,54,55,57-60 and 65-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5,14</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 March 2002 has been entered.

Drawings

The drawings are objected to because the sectional views are not properly cross-hatched (see MPEP 608.02). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 44, 45, 55, 65, and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3,383,564 (hereafter Lalmond).

Lalmond discloses, referring to figure 3-5, a electronic component comprising a substrate (31) including a conductive area (34); masking material (37) formed on said substrate, said masking material patterned to form an opening (40) corresponding to at least a portion of said conductive area and a main body portion; conductive material (60) deposited on said masking material within said opening and on said main body portion, said conductive material composing a contact structure comprising a base region electrically connected to said conductive area and formed within said opening and a main body region formed on said main body portion of said masking material, said main body region being integrally formed with said base region and displaced away from said substrate [claim 65], wherein at least a portion of the main body region is displaced from the substrate by a distance of between about 5 and 200 mils (see col. 4, lines 20-50) [claim 44], wherein at least a portion of the main body region is displaced from the substrate by a distance of between about 2 and 8 mils (see col. 4, lines 20-50) [claim 45], wherein the conductive material comprises a material selected from the group consisting of nickel, copper, cobalt, iron, gold, silver, elements of the platinum group, noble metals semi-noble metals, elements of the palladium group, tungsten, and molybdenum (see col. 5, lines 10-15) [claim 55], wherein said masking material comprises a plurality of masking layers (37, 38, 42) [claim 66].

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Claims 43, 46, 57-59, and 67-70 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3,846,166 (hereafter Saiki).

Saiki discloses, referring to figure 1c, a electronic component comprising a substrate (11) including a conductive area (12); masking material (13) formed on said substrate, said masking material patterned to form an opening (17, see figure 1b) corresponding to at least a portion of said conductive area and a main body portion; conductive material (18) deposited on said masking material within said opening and on said main body portion, said conductive material composing a contact structure comprising a base region electrically connected to said conductive area and formed within said opening and a main body region formed on said main body portion of said masking material, said main body region being integrally formed with said base region and displaced away from said substrate [claim 65], wherein the main body region is approximately parallel to a surface of the electronic component [claim 43], wherein said contact structure further comprises a sloped region disposed between the base region and the main body region [claim 46], wherein the substrate comprises a semiconductor device [claims 57, 59] that has been singulated from a wafer (see col. 5, lines 60-70) [claim 58], wherein said opening is tapered [claim 67], further comprising a terminal on a surface of said substrate [claim 68], said terminal being electrically connected to said conductive area [claim 69].

Similarly, Saiki discloses, referring to figure 1c, an electronic component comprising: a substrate (11) including at least one conductive element; conductive means (12) for providing an electrical connection with at least one of said conductive

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elements of said substrate; masking means (13) for forming a patterned mold comprising an opening (17) corresponding to at least a portion of said conductive means and a main body portion; contact means (18) for providing an electrical connection between said conductive means and a point displaced from said substrate, said contact means formed of a conductive material integrally deposited on said masking material means within said opening and on said main body portion, said contact means comprising: a base region formed on said conductive means within said opening, and a main body region formed on said main body portion of said masking means, said main body region being integrally formed with said base region and displaced away from said substrate [claim 70].

Claims 43, 46, 65, and 67-70 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,436,411 (hereafter Pasch).

Pasch discloses, referring to figure 1f, a electronic component comprising a substrate (104) including a conductive area (108); masking material (110) formed on said substrate, said masking material patterned to form an opening (112) corresponding to at least a portion of said conductive area and a main body portion; conductive material (114) deposited on said masking material within said opening and on said main body portion, said conductive material composing a contact structure comprising a base region electrically connected to said conductive area and formed within said opening and a main body region formed on said main body portion of said masking material, said main body region being integrally formed with said base region and displaced away

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from said substrate [claim 65], wherein the main body region is approximately parallel to a surface of the electronic component [claim 43], wherein said contact structure further comprises a sloped region (114a) disposed between the base region and the main body region [claim 46], wherein said opening is tapered [claim 67], further comprising a terminal on a surface of said substrate [claim 68], said terminal being electrically connected to said conductive area [claim 69].

Moreover, Pasch discloses, referring to figure 2f, an electronic component comprising: a substrate (204) including at least one conductive element (206); conductive means (208) for providing an electrical connection with at least one of said conductive elements of said substrate; masking means (210) for forming a patterned mold comprising an opening (212) corresponding to at least a portion of said conductive means and a main body portion; contact means (214) for providing an electrical connection between said conductive means and a point displaced from said substrate, said contact means formed of a conductive material integrally deposited on said masking material means within said opening and on said main body portion, said contact means comprising: a base region formed on said conductive means within said opening, and a main body region formed on said main body portion of said masking means, said main body region being integrally formed with said base region and displaced away from said substrate [claim 70].

Claims 41 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,461,775 (hereafter Tanabe).

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Tanabe discloses, referring to figure 1, a electronic component comprising a substrate (1) including a conductive area (2); masking material (3) formed on said substrate, said masking material patterned to form an opening corresponding to at least a portion of said conductive area and a main body portion; conductive material (4) deposited on said masking material within said opening and on said main body portion, said conductive material composing a contact structure comprising a base region electrically connected to said conductive area and formed within said opening and a main body region formed on said main body portion of said masking material, said main body region being integrally formed with said base region and displaced away from said substrate [claim 65], wherein the main body region comprises a curved portion [claim 41].

Claims 41, 60 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by US 4,436,766 (hereafter Williams).

Williams discloses, referring to figure 1, a electronic component comprising a substrate (11) including a conductive area (13); masking material (14) formed on said substrate, said masking material patterned to form an opening corresponding to at least a portion of said conductive area and a main body portion; conductive material (20) deposited on said masking material within said opening and on said main body portion, said conductive material composing a contact structure comprising a base region (20a) electrically connected to said conductive area and formed within said opening and a main body region (20c) formed on said main body portion of said masking material, said

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main body region being integrally formed with said base region and displaced away from said substrate [claim 65], wherein the main body region comprises a curved portion [claim 41], further comprising a separate tip structure (20b) joined permanently to the contact structure [claim 60].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pasch. Pasch discloses the claimed invention as described above with respect to claim 46, except Pasch does not specifically state that the sloped region has an average angle of between about 60 and about 75 degrees. However, it would have been obvious, to one having ordinary skill in the art, at the time of invention, to form the sloped region in such

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a manner since Pasch teaches that it is well known in the art to form slopes from between ninety degrees to thirty degrees (see col. 2, lines 30-40). Therefore, it would have been an obvious matter of design choice to one having ordinary skill in the art to select the 60 to 75 degree range. Furthermore, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Moreover, it has been held that more than a mere change of form is necessary for patentability. *Span-Deck, Inc v. Fab-Con, Inc.* (CA 8, 1982) 215 USPQ 835.

Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lalmond in view of US 5,416,278 (hereafter Ostrem).

Lalmond discloses the claimed invention as described above with respect to claim 65 except Lalmond does not specifically state that the conductive material comprises nickel. However, it would have been obvious, to one having ordinary skill in the art, at the time of invention, to form the conductive material of nickel instead of the copper disclosed in Lalmond since it is well known in the art to substitute nickel for copper as evidenced by Ostrem (see col. 1, line 60 – col. 2, line 5). Moreover, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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Response to Arguments

Applicant's arguments with respect to claims 41, 43-46, 49, 54, 55, 57-60, and 65-70 have been considered but are moot in view of the new ground(s) of rejection.

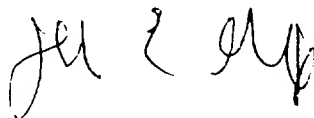
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy C. Norris whose telephone number is 703-306-5737. The examiner can normally be reached on Mon.-Th., 9AM - 6:30 PM and alt. Fri. 9AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on 703-305-9883. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0725 for regular communications and 703-308-0725 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

JCSN
June 24, 2003



**DAVID E. GRAYBILL
PRIMARY EXAMINER**

Notice of References Cited	Application/Control No. 09/539,287	Applicant(s)/Patent Under Reexamination PEDERSEN ET AL.	
	Examiner Jeremy C. Norris	Art Unit 2827	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-3,383,564	05-1968	Lalmond et al.	174/254
	B	US-3,846,166	11-1974	Saiki et al.	427/99
	C	US-4,436,766	03-1984	Williams, Ralph E.	427/96
	D	US-5,416,278	05-1995	Ostrem et al.	174/263
	E	US-5,436,411	07-1995	Pasch, Nicholas F.	174/261
	F	US-5,461,775	10-1995	Tanabe et al.	29/840
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

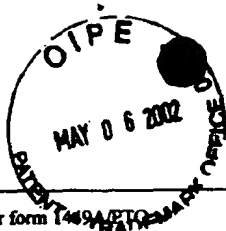
FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



Modified Form PTO/SB/08A

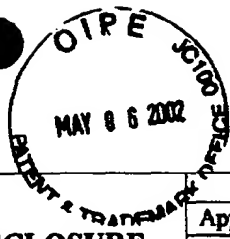
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)			<i>Complete If Known</i>		
			Application Number	09/539,287	
			Filing Date	March 30, 2000	
			First Named Inventor	Pedersen et al.	
			Group Art Unit	2841	
			Examiner Name	Q. Vu	
Sheet	1	of	2	Attorney Docket No.	P48D1-US

U.S. PATENT DOCUMENTS						
Examiner Initials ¹	Cite No. ¹	U.S. Patent Document		Name of Patentee or Applicant	Publication Date	Relevant Portions
		Number	Kind Code ²			
QV	1	2002/19152	A1	Eldridge et al.	2/14/2002	
	2	5070297		Kwon et al.	12/3/1991	
	3	5172050		Swapp	12/15/1992	
	4	5177438		Littlebury et al.	6/5/1993	
	5	5191708		Kasukabe et al.	3/9/1993	
	6	5391521		Kim	2/21/1995	
	7	5455390		DiStefano et al.		
	8	5465611		Ruf et al.	11/14/1995	
	9	5476211		Khandros	12/19/1995	
	10	5476818		Yanof et al.	12/19/1995	
	11	5477611		Sweis et al.	12/26/1995	
	12	5495667		Farnworth et al.	3/5/1996	
	13	5513430		Yanof et al.	5/7/1996	
	14	5666190		Quate et al.	9/9/1997	
	15	5828226		Higgins et al.	10/27/1998	
	16	5897326		Eldridge et al.	4/27/1999	
	17	5994152		Khandros et al.	11/30/1999	
	18	6014032		Maddix et al.	1/11/2000	
	19	6059982		Palagonia et al.	5/9/2000	
	20	6064213		Khandros et al.	5/16/2000	
	W	21	6184053		Eldridge et al.	2/6/2001

Examiner Signature	Jeremy Norris	Date Considered	6-24-03
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication

¹Unique citation designation number. ²See attached Kinds of U.S. Patent Documents. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶Applicant is to place a check mark here if English language Translation is attached.



Modified Form PTO/SB/08A

Substitute for form 1449A/PTO			Complete If Known		
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)			Application Number	09/539,287	
			Filing Date	March 30, 2000	
			First Named Inventor	Pedersen et al.	
			Group Art Unit	2841	
			Examiner Name	Q. Vu	
Sheet	2	of	2	Attorney Docket No.	P48D1-US

FOREIGN PATENT DOCUMENTS								
Examiner Initials ⁵	Cite No. ¹	Foreign Patent Document			Name of Patentee or Applicant	Publication Date	Relevant Portions	T ⁶
		Office ²	Number ³	Kind Code ⁴				
JES	22	CH	661129	A5		6/30/1987		
	23	JP	7-021968		w/ English abstract	1/24/1995		
	24	WO	96/02068		DiStefano et al.	1/25/1996		
	25	WO	97/43653		Khandros et al.	11/20/1997		

OTHER PRIOR ART - NONPATENT LITERATURE DOCUMENTS				
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published		T ²
JES	26	ABOLAFIA, "Tapered Vias In A Photosensitive Dielectric Film," IBM Technical Disclosure Bulletin, vol. 21 no. 12 (May 1979), pg. 4787		
	27	"Robust Method Using Simple Unit Processes For Thin Film Cu-Polyimide Packaging Structures," IBM Technical Disclosure Bulletin, vol. 34 no. 10A (March 1992), pp. 368-69		
	28	KONG et al., "Integrated Electrostatically Resonant Scan Tip For An Atomic Force Microscope," Journal of Vacuum Science & Technology, Vol. 11 No. 3 (May/June 1993), pp. 634-641		
	29	"Thin Film Substrate For Wire Bonding," IBM Technical Disclosure Bulletin, vol. 32 No. 10A (March 1990), pp. 80-81		

Examiner Signature	<i>Jenny Norris</i>	Date Considered	6-24-03
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication

¹Unique citation designation number. ²See attached Kinds of U.S. Patent Documents. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶Applicant is to place a check mark here if English language Translation is attached.

The United States Patent and Trademark Office has changed certain mailing addresses!

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Use the address provided in this flyer after May 1, 2003 for any correspondence with the United States Patent and Trademark Office (USPTO) in patent-related matters to organizations reporting to the Commissioner for Patents.

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Also effective May 1, 2003, the USPTO is changing the special Box designations for **Patents and Trademarks** to corresponding Mail Stop designations (e.g., "Box 4" will now be "Mail Stop 4").

For further information, see *Correspondence with the United States Patent and Trademark Office*, 68 *Fed. Reg.* 14332 (March 25, 2003). A copy of the *Federal Register* notice is available on the USPTO's web site at <http://www.uspto.gov/web/menu/current.html#register>

A listing of specific USPTO mailing addresses (See Patents – specific) will be available on the USPTO's web site on April 15, 2003 at <http://www.uspto.gov/main/contacts.htm>

Persons filing correspondence with the Office should check the rules of practice, the Official Gazette, or the Office's Internet Web site (www.uspto.gov) to determine the appropriate address and Mail Stop Designation (if applicable) for all correspondence being delivered to the USPTO via the United States Postal Service (USPS).

Questions regarding the content of this flyer should be directed to the Inventor Assistance Center at (703) 308-4357 or toll-free at 1-800-786-9199.

REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 Fed. Reg. 38611 (June 30, 2003)), posted on the Office's website at: <http://www.uspto.gov/web/patents/ifw/> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period.

Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.

Note: The amendment practice for reissues and reexamination proceedings, except for drawings, has not changed.

REVISED AMENDMENT PRACTICE

I. Begin each section of an amendment document on a separate sheet:

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

II. Two versions of amended part(s) no longer required:

37 CFR 1.121 has been revised to **no longer require two versions** (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for **substitute specifications** under 37 CFR 1.125 have been retained.

A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and **the text of each pending claim** (with markings to show **current** changes) must be presented. The claims in the listing will replace all prior claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), **(previously presented) and (not entered)**. The text of all pending claims, **including withdrawn claims**, must be submitted each time any claim is amended. Canceled **and not entered** claims must be indicated by only the claim number and status, without presenting the text of the claims.
- (2) The text of all claims **being currently amended** must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for **deletion of five characters or fewer, double brackets may be used (e.g., [[error]]**; and (2) if **strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]])**. **As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., ~~number 4~~ as number 14 as).** An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.
- (3) The text of pending claims **not being currently amended, including withdrawn claims**, must be presented in the claim listing in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

- (4) A claim being canceled must be listed in the claim listing with the status identifier "canceled"; the text of the claim must not be presented. Providing an instruction to cancel is optional.
- (5) Any claims added by amendment must be presented in the claim listing with the status identifier "(new)"; the text of the claim must not be underlined.
- (6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

Example of listing of claims (use of the word "claim" before the claim number is optional):

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

B) Amendments to the specification:

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as)

C) Amendments to drawing figures:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. Any marked-up (annotated) copy showing changes must be labeled "Annotated Sheet Showing Changes" and accompany the replacement sheet as an appendix to the amendment. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to patent.practice@uspto.gov or by phone at (703) 305-1616.

NOTIFICATION OF REQUESTED NEW FORMAT FOR AMENDMENTS AND/OR RESPONSES FILED IN ART UNITS 1634, 2827, AND 2834

The United States Patent and Trademark Office (USPTO) is currently conducting a prototype of electronic application processing and examination in Art Units 1634, 2827, and 2834. To facilitate the prototype, the following changes in format for Amendments and or Responses filed in those Art Units are requested.

Requested Format of Amendments and Responses during the prototype.

Each section of an Amendment and/or Response (e.g., Claim Amendments, Specification Amendments, Remarks) should begin on a separate sheet to facilitate separate indexing and scanning of the document. *For example*, in an Amendment containing a.) introductory comments, b.) amendments to the claims, c.) amendments to the specification, and d.) remarks, each of these sections should begin on a separate sheet. **For each amendment filed in Art Units 1634, 2827, and 2834, the requirement to provide two sets of claims (a clean version and a marked up version), as set forth in 37 CFR 1.121(c), will be waived where the following format is employed.**

Each amendment that includes a change to an existing claim, or submission of a new claim shall be made by submitting a summary document with the status of all claims and the text of all pending claims as follows:

- (1) The status of all of the claims in the application, including any previously canceled or withdrawn claims, must be summarized in each amendment document. Status is indicated by a parenthetical expression following the claim number (e.g. (original), (currently amended), (previously amended), (canceled), (withdrawn), or (new)). The text of all pending claims must be submitted each time any claim is amended. Canceled and withdrawn claims may be indicated by only the claim number and status.
- (2) All claims being currently amended must be submitted with markings to indicate the changes that have been made. The changes in any amended claim may be shown by strikethrough (for deleted matter) or underlining (for added matter), or by any equivalent marking system.
- (3) The text of pending claims not being amended must be presented in each amendment document in clean version, i.e., without any markings. Any claim presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version.
- (4) A claim may be canceled by merely providing an instruction to cancel. Any claims added by amendment must be indicated as (new).
- (5) All of the claims in each amendment paper must be presented in ascending numerical order. Consecutive canceled or withdrawn claims may be aggregated into one statement (e.g. Claims 1 – 5 (canceled)).

Amendments to the specification are performed in the conventional manner (37 CFR 1.121(b)).

Patent Copies

Additionally, applicants and practitioners will no longer be required to provide copies of U.S. Patents and Published U.S. Patent Applications cited in any Information Disclosure Statement (IDS) submitted to the USPTO during the prototype and in applications assigned to the three art units. It is requested that eIDSs be used to file all IDS papers for applications before the prototype Art Units. Similarly, during the prototype, copies of U.S. Patents and Published U.S. Patent Applications cited by an examiner during prosecution of an application will not be provided to applicants in Office actions from these Art Units. These documents are available from the USPTO web site, www.uspto.gov for free download. Cited foreign patents and published applications and non-patent literature will be mailed by conventional processing.

The above requested new format and procedures are applicable during the prototype only to applications assigned to Art Units 1634, 2827, and 2834. Any questions regarding these requirements may be directed to image.processing@uspto.gov or one of the Supervisory Patent Examiners of these Art Units 1634 – Gary.Jones@uspto.gov; 2827 – Dave.Jalbutt@uspto.gov or 2834 – Nestor.Ramirez@uspto.gov.

Example:

Claims 1-5 (canceled) (Note: consecutive canceled or withdrawn claims may be aggregated)

Claim 6 (withdrawn)

Claim 7 (previously amended): A bucket with a handle.

Claim 8 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 9 (withdrawn)

Claim 10 (original): A bucket with a wooden handle.

Claim 11: (new): A bucket with plastic sides and bottom.

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U. S. DEPARTMENT OF COMMERCE
PATENT AND TRADE-MARK OFFICE
WASHINGTON, DC 20231

IF UNDELIVERABLE RETURN IN TEN DAYS

OFFICIAL BUSINESS

AN EQUAL OPPORTUNITY EMPLOYER

- ☐ Not Deliverable As Addressed
- ☐ Unable To Forward
- ☐ Insufficient Address
- ☒ Moved, Left No Address
- ☐ Undelivered - No Return
- ☐ Attempted - Not Known
- ☐ No Such Street Number
- ☐ Vacant ☐ Illegible
- ☐ No Mail Receipts
- ☐ Box Closed